

REMARKS

Applicant has amended claim 3 simply to add non-limiting clarifying language without narrowing claim scope. Applicant also provides a clean copy of the amended Abstract starting on a separate page in order to avoid quality control issues when the application is allowed.

The Examiner has objected to the specification because of alleged inconsistencies in terminology. Applicant respectfully traverses this objection and would point out that patent specifications are intended to be read by persons skilled in the art, who would not be confused by the use of different terms to describe possible different shapes of corresponding structural elements. For example, a “bore” or a “slit” is a kind of “recess,” a “pin” or a “ridge” is a kind of “projection” and an “end face” certainly can be an “abutment surface.” Thus, correcting the specification as requested by the Examiner is not necessary to make the disclosure clear to persons skilled in the art, does not make the disclosure more accurate and does not, applicant respectfully submits, improve the quality of the disclosure.

Claims 3 and 4 stand rejected as anticipated by Neumann U.S. Patent Publication No. 2002/0082695 (Neumann). The Examiner kindly provided on page 4 of the Action a graphical representation of where she found each of the claim elements disclosed in the reference. Applicant respectfully traverses this rejection.

The rejection fails to take into account the requirement in the language of original claim 1 and replacement claim 3 that the holder be separate from the cervical prosthesis and the insertion instrument, a feature which Neumann fails to disclose or suggest. In claim 3, the Examiner will note that there is a comma between “cervical prosthesis” and “ an insertion instrument,” which means that the “cervical prosthesis” and “insertion instrument” are the first two items in a list of separate components of the claimed implanting device, the third item being the holder. If claim 3 were to cover a two-element combination of a cervical prosthesis and an insertion instrument that includes both the gripping members and the holder, there would be no comma between “cervical prosthesis” and “insertion instrument.” Instead, the word “and” would appear between

the words “cervical prosthesis” and “insertion instrument.” Furthermore, the “wherein” clause in claim 3 would make no sense if the holder were not physically separate from the insertion instrument. Accordingly, it is not reasonable to interpret claim 3 as originally presented as covering an implanting device in which the holder is not separate from the insertion instrument.

On page 3 of the Action, the Examiner states that Neumann’s element 29 corresponds to the claimed holder, yet the marked-up drawings on page 4 of the Action label element 29 as being a gripping member, which is on the claimed insertion instrument and not on the holder. The drawings on page 4 of the Action are correct: Neumann’s element 29 is disclosed in paragraph [0031] to be the lower fork of a holder 26 that is part of the insertion instrument and is designed to be complementary to the holder grooves 17 on the sleeve part of the implant. Although Neumann calls grooves 17 “holder grooves,” they are not grooves on a holder but are instead grooves on sleeve part 2 of the implant itself. See paragraphs [0027] and [0030]. There is no separate holder in Neumann’s device. Furthermore, Neumann’s device is not capable of functioning in accordance with the “wherein” clause of claim 3, which defines the structural relationship among the cervical prosthesis, the holder and the insertion instrument. As a result, Neumann neither identically discloses the subject matter of claims 3 and 4 nor provides a motivation to make the claimed implanting device.

Applicant notes the indication in Block 10 of the Office Action Summary that “The drawing(s) filed on 6/6/04 are accepted.” Applicant did not file anything on that date; he filed the response to the Notice to File Missing Parts on June 16, 2004, and did not include formal drawings at that time. Applicant now files the attached formal drawings for this application.

Early action allowing claims 3 and 4 is solicited.

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge

the cost of such petitions and/or other fees due in connection with the filing of this document to
Deposit Account No. 03-1952 referencing Docket No. 246472005300.

Respectfully submitted,



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